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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207216
Party	Plaintiff Nathan Aweida
Correspondence Address	JONATHAN I FEIL SIMBURG KETTER SHEPPARD PURDY LLP 999 THIRD AVENUE , SUITE 2525 SEATTLE, WA 98104 4089 UNITED STATES jfeil@sksp.com
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Date	05/22/2014
Attachments	Opposer-response to motion to dismiss.pdf(1754722 bytes)

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6 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
7 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

8 In the matter of trademark application Serial No.: 85374436

9 For the mark: SWISS PERC (Stylized/Design)

10 Published in the Official Gazette on: May 29, 2012

11 NATHAN AWEIDA,

Opposition No. 91207216

12 Opposer/Plaintiff,

13 v.

14 PURE GLASS DISTRIBUTION, INC.,

15 Applicant/Defendant.

16 **OPPOSER'S RESPONSE TO MOTION FOR INVOLUNTARY DISMISSAL AND**
17 **(1) REQUEST FOR VOLUNTARY PARTIAL DISMISSAL AND (2) SUSPENSION**
18 **OF REMAINING ISSUES PENDING OUTCOME OF CIVIL ACTION**

19 Opposer requests that the Board deny the Applicant's motion for involuntary
20 dismissal of the pending opposition, enter a voluntary partial dismissal, and suspend the
21 remaining Board proceeding pending the outcome of a civil case filed in United States
22 District Court directly bearing on the Board case.

23 This response is supported by the following exhibits attached hereto:

Exhibit 1 Complaint for Trademark Infringement, Unfair Competition, and False Description, filed May 20, 2014, in *Aweida Arts, Inc. v. Pure Glass Distribution, Inc.*, Case No. 2:14-cv-757, United States District Court for the Western District of Washington

Exhibit 2 Excerpts from the application file Serial No.: 85374436, for the mark: SWISS PERC (Stylized/Design), filed by Defendant and at issue in this opposition

Exhibit 3 Excerpts from the application file Serial No.: 85407750, for the mark: SWISSPERC (words only), filed by Opposer

Exhibit 4 Declaration of Jonathan Feil

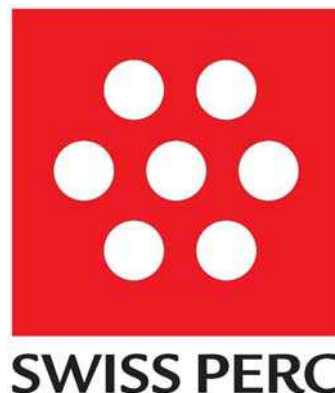
Exhibit 5 Provisions for Protecting Confidentiality of Information Revealed During Board Proceeding, signed by the parties on December 12, 2012

Exhibit 6 [Proposed] Amended Notice of Opposition

In addition, Opposer is submitting a confidential statement under seal, for the reasons explained in the declaration.

BACKGROUND

(1) Defendant's Application. On July 21, 2011, Defendant filed an application for registration of the wording "SWISS PERC" in stylized form beneath a design consisting of a red square containing seven white circles arranged in a larger circle, for accessories for tobacco water pipes, namely, bowls in Class 34:



1 (2) Disclaimer of Wording. On September 27, 2011, the trademark examining
2 attorney issued an office action *inter alia* requiring Defendant to “disclaim the descriptive
3 wording ‘Swiss perc’ apart from the mark as shown,” based on attached excerpts from
4 various website, which the examining attorney asserted “shows that ‘Swiss perc’ identifies a
5 type of water pipe,” namely a design “which features a bowl containing numerous holes in
6 the glass, like Swiss cheese.” Responding to the examining attorney, Defendant submitted a
7 disclaimer of the entire wording in the mark. (**Exhibit 2.**)

8 (3) Publication and Opposition. The mark was published in the Official Gazette
9 on May 29, 2012, and this opposition ensued on September 28, 2012, following the grant of a
10 90-day extension based on Opposer’s explanation in part that “[t]he potential opposer needs
11 additional time to pursue a demand made to applicant’s counsel during the pendency of the
12 application that the application be withdrawn.”

13 (4) Basis of Opposition. There are effectively two grounds for the opposition:

14 (a) *Word Mark*. The Opposition alleges that “SwissPerc” is not the
15 descriptive name for the style or type of goods. Rather, “SwissPerc” is a suggestive term
16 coined by Mr. Aweida to identify the products with him as a glass artist and his company,
17 Aweida Arts, Inc., as the exclusive market source. Opposer was the first to use the mark in
18 commerce in the markets of glass art or glass water pipes, and the mark’s adoption and use
19 preceded Defendant’s adoption and use of “Swiss Perc” by a considerable period.

20 (b) *Design Mark*. The Opposition alleges that the design described in
21 paragraph (1) is confusingly similar to a design which Opposer created and used at least as
22 early as April 2008 in visual appearance characteristics of its products as a source identifier.
23

1 (5) Opposer's Application. On August 25, 2011, Opposer filed an application to
2 register "SwissPerc" as a word mark only, under Serial No. 85407750. On July 6, 2012, the
3 trademark examining attorney suspended action on the application based on Defendant's
4 prior-filed Application Serial No(s). 85374436. (**Exhibit 3.**)

5 (6) Initiation of Civil Action.

6 (a) *Bog-down of Discovery.* Progress of the Opposition proceeding
7 became bogged down in discovery, due in part to the refusal of Defendant to commit to a
8 date for the deposition of its president, Minh Vo. At the same time, Opposer refused to
9 provide responses to written discovery that had been served after the originally-noted date for
10 Mr. Vo's deposition, on the basis that it was entitled to priority in the sequence of discovery.
11 The period for taking discovery was extended multiple times by agreement while counsel
12 attempted to work out the roadblock.

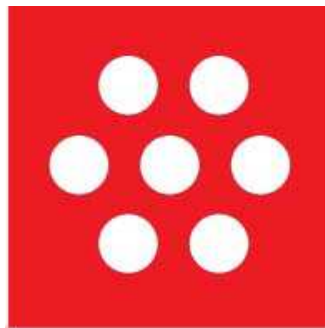
13 (b) *Court Action Required for Full Relief.* From Opposer's perspective,
14 the aim of this Opposition was to induce Defendant to discontinue using the mark claimed by
15 Opposer without litigating damages, as well as clearing the obstacle to Opposer's own
16 registration. As this proceeding bogged down, it became clear that the TTAB proceeding had
17 become pointless, and that a civil action under Lanham Act 43(a) was needed to provide
18 Opposer full relief on his claims, including damages, and to toll the statute of limitations.

19 On that basis, Opposer has filed the complaint shown in **Exhibit 1** in the United
20 States District Court for the Western District of Washington. It is pending as *Aweida Arts,*
21 *Inc. v. Pure Glass Distribution, Inc.*, Case No. 2:14-cv-757.

22 (c) *Withdrawal of Claim Against Defendant's Design.* Opposer has
23 concluded that the design described in paragraph (1) does not cause confusion at a level

1 sufficient to warrant the substantial time and expense of continued litigation on that issue,
2 and wishes to conserve resources to concentrate on enforcing its rights in the SwissPerc word
3 mark. Accordingly, Opposer is willing to dismiss voluntarily its claim against the design
4 portion of Defendant's mark, while retaining only the Opposition to the words portion of the
5 mark.

6 This position also means that if Defendant agrees to amend the drawing to remove the
7 wording (which Defendant has already disclaimed), Opposer would voluntarily dismiss the
8 Opposition entirely on that basis and consent to the registration of the design mark shown as
9 follows:



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15 (7) Good and Sufficient Cause for Failure to Prosecute. Opposer acknowledges
16 that these actions should properly have been taken sooner, before the trial period. Opposer
17 offers the attached declaration of its counsel (**Exhibit 4**) and the accompanying confidential
18 statement as evidence of "good and sufficient cause" under 37 CFR § 2.132 and
19 TMBP 534.02. The confidential statement is being filed under seal pursuant to the Provisions
20 for Protecting Confidentiality of Information Revealed During Board Proceeding, signed by
21 the parties on December 12, 2012 (**Exhibit 5**).
22
23

1 **ARGUMENT**

2 (1) The Board Should Suspend Proceedings. 37 CFR §2.117(a) provides that the
3 proceedings may be suspended “[w]henever it shall come to the attention of the Trademark
4 Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action
5 ... which may have a bearing on the case.”

6 As TMBP 510.02(a) notes, the principal circumstance justifying suspension is “a civil
7 action in a federal district court [which] involves issues in common with those in a
8 proceeding before the Board.” In that situation, “the decision of the federal district court is
9 often binding upon the Board, while the decision of the Board is not binding upon the court.”

10 That situation is present here. The District Court action is between the same parties in
11 interest. Opposer’s action for unfair competition and false description directly involves
12 whether Defendant’s use of “SWISS PERC” violates 15 U.S.C. §1125(a), and as a result,
13 whether its use must be enjoined and Defendant held liable for the damages resulting from
14 that use. These are matters not before the Board in this case, nor within the statutory
15 jurisdiction of the Board.

16 Furthermore, because of Defendant’s voluntary disclaimer, its right to the “SWISS
17 PERC” wording is not squarely before the Board. A decision of the Board will therefore not
18 determine the issues before the District Court. By contrast, the civil action will be conclusive
19 to the pending opposition, by determining whether Defendant has the right to include that
20 matter in its registration, even with a disclaimer, or whether that disqualifies the Defendant’s
21 composite mark under 15 U.S.C. §1051(d). Thus, the District Court’s decision will determine
22 the ultimate issue in the Opposition without need for further evidence.
23

1 Opposer recognizes that under 37 CFR §2.117(b), the Board has discretion when a
2 potentially dispositive motion is before the Board, to decide it before the question of
3 suspension is considered. In view of the above discussion, it would not serve the interests of
4 justice to put the pending motion to dismiss ahead of the question of suspension. The
5 questions in the motion to dismiss and request to suspend are interwoven.

6 (2) Voluntary Partial Dismissal. As noted above on page 4, Opposer is willing to
7 dismiss voluntarily its claim against the design portion of Defendant's mark, and would
8 consent to an order to that effect. Attached **Exhibit 6** shows the matter which should be
9 removed from the Notice of Opposition in accordance with such partial dismissal. Entry of
10 such a partial dismissal also means that the remaining issues in the Opposition parallel and
11 do not exceed the issues in the District Court action.

12 (3) Good and Sufficient Cause. If the foregoing points are not sufficient to justify
13 suspension of the proceeding instead of dismissal under 37 CFR § 2.132, Opposer submits
14 that there is "good and sufficient cause," equivalent to the "excusable neglect" standard
15 under Fed. R. Civ. P. 6(b), which alone is sufficient cause to deny the motion.

16 Ordinarily, denying a motion for involuntary dismissal under 37 CFR § 2.132 reopens
17 the plaintiff's testimony period. However, in this instance, we expect that there will be no
18 need for testimony after the court action is determined. As discussed above, the District
19 Court case will determine finally Defendant's right to include "SWISS PERC" in its
20 registered mark. Hence, no prejudice to the Defendant or the Board arises from denying the
21
22
23

1 Motion for Involuntary Dismissal and suspending the proceedings during the pendency of the
2 District Court case.¹

3 **CONCLUSION**

4 For the reasons stated above, we request that the Board:

- 5 (1) Deny Defendant's Motion for Involuntary Dismissal;
6 (2) Grant Opposer's Motion for Voluntary Dismissal; and
7 (3) Issue a suspension of proceedings pending the outcome of the District Court
8 action.

9 DATED: May 22, 2014

10 Respectfully submitted,

11 SIMBURG, KETTER, SHEPPARD & PURDY, LLP

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13 By:



14 Jonathan I. Feil (WSBA # 14166)
15 Attorneys for Opposer/Plaintiff, Nathan Aweida
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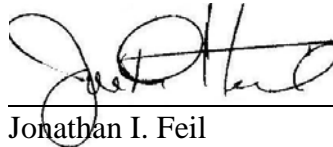
21 ¹ Indeed, as discussed above, Opposer would voluntarily dismiss the entire opposition if
22 Defendant consents to the amendment of the drawing to remove the wording element. This
23 should be of little concern to Defendant, since it has disclaimed exclusive rights in the
wording. The pending District Court case would then be the exclusive forum for determining
whether Defendant's use of "SWISS PERC" is in violation of Opposer's rights.

1 **CERTIFICATE OF SERVICE**

2 I certify that on this date a copy of the foregoing document was served by electronic
3 mail, by agreement, addressed to counsel for the Applicant/Defendant:

4 Eric S. Hyman [eric_hyman@bstz.com]
5 Pete Bromaghim [pete_bromaghim@bstz.com]
6 Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Blvd Fl 7
Los Angeles, CA 90025-1019

7 DATED: May 22, 2014

8 
9 _____
Jonathan I. Feil

10 SIMBURG, KETTER, SHEPPARD & PURDY, LLP
11 999 Third Avenue, Suite 2525
12 Seattle, WA 98104
13 Telephone: (206) 382-2600
14 Fax: (206) 223-3929
15 E-mail: jfeil@sksp.com
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Exhibit 1

Complaint for Trademark Infringement,
Unfair Competition, and False Description,
filed May 20, 2014, in *Aweida Arts, Inc. v.*
Pure Glass Distribution, Inc.,
Case No. 2:14-cv-757,
United States District Court for the
Western District of Washington

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6 **UNITED STATES DISTRICT COURT**
7 **WESTERN DISTRICT OF WASHINGTON**

8 AWEIDA ARTS, INC., a Washington
9 corporation,

10 Plaintiff,

11 v.

12 PURE GLASS DISTRIBUTION, INC.,
13 a California corporation,

Defendant.

NO. 2:14-cv-757

COMPLAINT FOR TRADEMARK
INFRINGEMENT, UNFAIR
COMPETITION, AND FALSE
DESCRIPTION

JURY DEMAND

14 Plaintiff Aweida Arts, Inc. (“Aweida Arts” or “Plaintiff”), by and through the
15 undersigned counsel, hereby alleges as follows:

16 **NATURE OF ACTION**

17 1. This is a complaint for unfair competition and false description arising under
18 §43(a) of the Lanham Act, 15 U.S.C. §1125(a), for trademark infringement and unfair and
19 deceptive business competition under state law, and for common law injury to business
20 reputation, arising from Defendant’s deliberate appropriation and use of the Plaintiff’s
21 “SwissPerc” mark to promote and sell commercially identical or closely related goods of
22 Defendant.
23

PARTIES

2. Plaintiff is a corporation formed under the laws of the State of Washington, with its principal business office located at 1300 S Dearborn Street, Seattle, Washington 98144.


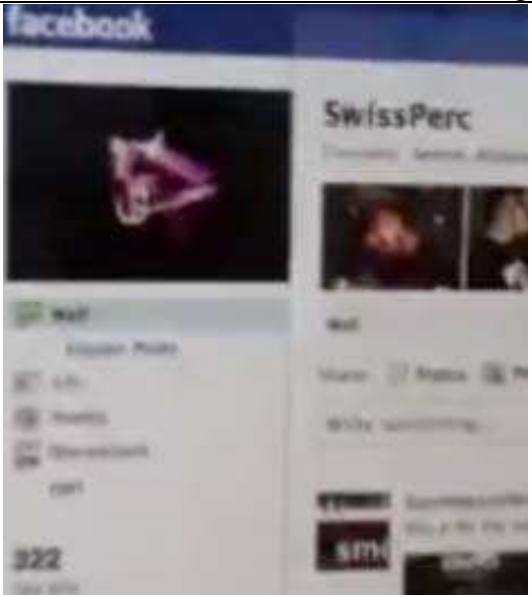
3. Pure Glass Distribution, Inc. (“Pure Glass” or “Defendant”) is a corporation formed under the laws of California, with its principal business office located at 5649 E. Washington Blvd., Commerce, California 90040.

JURISDICTION AND VENUE

4. This court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§1331 and 1338. This court has related claim jurisdiction over the state law tort claims pursuant to 28 U.S.C. §1338(b) and 28 U.S.C. §1367.

5. This Court has personal jurisdiction over the Defendant with respect to this action, because: (a) Defendant purposefully has availed itself of the privileges of conducting business in the forum state, (b) the claims arise out of or relate to Defendant’s forum-related activities, and (c) the exercise of jurisdiction over Defendant in this case is reasonable. Specifically, Defendant committed one or more intentional acts, which were expressly aimed at the forum state, and caused harm to Plaintiff, the brunt of which was and continues to be suffered by Plaintiff, and which the Defendant knew would be likely to be suffered in the forum state. Such activity included, but is not limited to, Defendant’s placement of a Facebook link on its website (**Figure 1, Column A**) which directed viewers from Defendant’s website to Plaintiff’s “SwissPerc” Facebook page (**Figure 1, Column B**), thus passing off Defendant’s SwissPerc designs as Plaintiff’s.

Figure 1
Screen shots from video captured on or about August 29, 2011

Column A (Defendant's Website links...)	Column B (...to Plaintiff's "SwissPerc" Facebook Page)
	

6. Venue is proper in this judicial district under 28 U.S.C. §1391(b) in that Defendant is subject to the personal jurisdiction of this Court with respect to this action or a substantial part of the events giving rise to Plaintiff's claims occurred in or were aimed at this district.

FACTS

7. Plaintiff was founded on or about August 3, 2010 by Nathan Aweida. Under the name Nate Dizzle, Mr. Aweida is a highly regarded glass artist, known to glass blowers and glass collectors alike, thanks to his technical skills and dedication, and his famous "SwissPerc" design. Mr. Aweida has drawn inspiration from his travels and channels his creativity into these beautiful glass sculptures that double as high-end glass water pipes. Aweida Arts operates a glass studio and glass art school in Seattle, Washington.

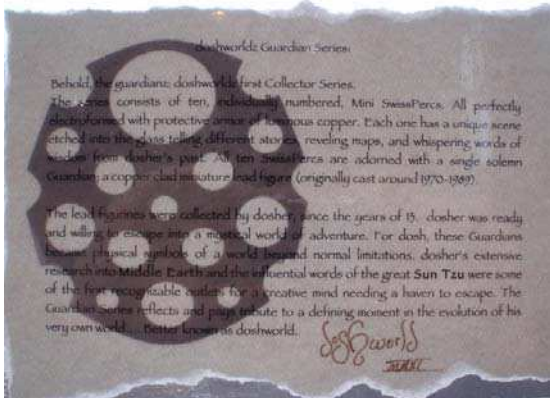
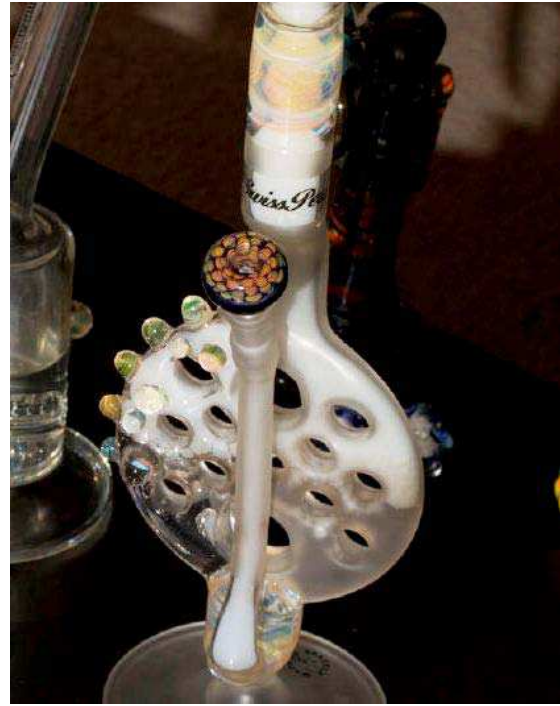
8. Since at least as early as April 2008, Mr. Aweida began developing the design that he named "SwissPerc." On or about March 13, 2009, Mr. Aweida registered the Internet domain name "swissperc.com."

9. Since at least as early as August 31, 2010, Aweida Arts has produced, distributed, marketed, and sold a line of glass sculptures that double as high-end glass water pipes under the mark "SwissPerc." The name was developed and is owned by Mr. Aweida, and licensed exclusively to Aweida Arts. Since at least that date, Aweida Arts has used the mark anywhere and in interstate commerce and/or other commerce which Congress can regulate. Plaintiff was the first to use the mark in the markets of glass art or glass water pipes, and its adoption and use preceded Defendant's adoption and use of "Swiss Perc" by a considerable period.

10. The following **Figure 2** shows representative examples of the "SwissPerc" mark as applied to Plaintiff's goods and for promotional purposes:

Figure 2.
Sample of Plaintiff's "SwissPerc" glass water pipes
and promotional use of mark





11. Apart from its association and source identification with Aweida Arts and Mr. Aweida aka Nate Dizzle, the wording "SwissPerc" does not have any commercial significance, nor is it a term of art, in the glass art or water pipe trade or industry. The wording "SwissPerc" is a suggestive term coined by Mr. Aweida to identify the products with him as a glass artist. The mark has not become the descriptive name for the style or type of goods among relevant

1 consumers and industry buyers. The wording “SwissPerc” identifies the goods as originating
 2 with Aweida Arts and Mr. Aweida.

3 12. Since approximately September 1, 2011, Defendant has used the wording
 4 “SwissPerc” (or the virtually identical variant “Swiss Perc”) to promote, market, and sell glass
 5 water pipes that are commercially identical or closely related goods in competition with
 6 Plaintiff. The following **Figure 3** shows representative examples of the “Swiss Perc” mark as
 7 applied to Defendant’s goods. Defendant has also used a webpage at the address
 8 <http://pureglass420.com/swiss-perc-50> to promote and market its glass water pipes.

9 **Figure 3.**
 10 **Samples of Defendant’s “Swiss Perc” glass water pipes**





13. On information and belief, Defendant selected and adopted “Swiss Perc” as the name for its glass water pipes specifically as a knock-off of Plaintiff’s “SwissPerc” mark.

14. On or about October 27, 2011, Plaintiff issued a demand *inter alia* that Defendant promptly: (a) discontinue use of “Swiss Perc” along with any confusingly similar name; (b) remove the webpage at <http://pureglass420.com/swiss-perc-50> from its website; (c) discontinue immediately offering the designs displayed on that page branded as “SwissPerc;” and (d) certify that it had destroyed all remaining infringing inventory. Defendant refused to comply, and has also refused to comply with repeated demands to that effect.

UNFAIR COMPETITION UNDER 15 U.S.C. §1125(a)

15. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the allegations in paragraphs 1 through 14 above.

1 16. Defendant's use of Aweida Art's mark to promote, market, and sell its products
2 constitutes Unfair Competition in violation of 15 U.S.C. §1125(a). Defendant's use of Aweida
3 Arts's mark is likely to cause confusion, to cause mistake, and to deceive consumers.
4 Defendant's actions have caused and will continue to cause damage to Aweida Arts, and are
5 causing irreparable harm to Aweida Arts for which there is no adequate remedy at law.

6 **FALSE DESCRIPTION UNDER 5 U.S.C. §1125(a)**

7 17. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the
8 allegations in paragraphs 1 through 16 above.

9 18. Defendant's wrongful use of Aweida Arts's mark is such a colorable imitation
10 and copy of Aweida Arts's trademark in the market for glass water pipes that Defendant's use
11 thereof in that context to promote, market, or sell its products is likely to cause confusion, or to
12 cause mistake, and to deceive consumers as to the affiliation, connection, or association of
13 Aweida Arts's products, or to deceive consumers as to the origin, sponsorship, or approval by
14 Aweida Arts of Defendant's products.

15 19. Defendant's use of the name "Swiss Perc" comprises a false description or
16 representation of Defendant's business or products under Section 43(a) of the Lanham Act,
17 15 U.S.C. §1125(a).

18 20. Defendant's acts of false description or representation have caused and will
19 continue to cause damage to Aweida Arts, and are causing irreparable harm to Aweida Arts for
20 which there is no adequate remedy at law.

21 **TRADEMARK INFRINGEMENT UNDER STATE LAW**

22 21. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the
23 allegations in paragraphs 1 through 20 above.

22. Defendant's wrongful use of the name "Swiss Perc" comprises an infringement of Aweida Arts's rights in its trademark, and is likely to cause confusion, mistake, and deception of the public as to the identity, origin, and source of Aweida Arts's goods, causing damages to Aweida Arts and causing Aweida Arts irreparable harm for which there is no adequate remedy at law.

23. By reason of the foregoing acts, Defendant is liable to Aweida Arts for trademark infringement under state law.

COMMON LAW INJURY TO BUSINESS REPUTATION

24. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the allegations in paragraphs 1 through 23 above.

25. Defendant's wrongful use of Aweida Arts's trademark inures to and creates a likelihood of injury to Aweida Arts's business reputation, because persons encountering Defendant's products will believe that Aweida Arts is affiliated or related to or has given approval to Defendant, and any adverse reaction by the public to Defendant and the quality of its products and the nature of its business will injure the business reputation of Aweida Arts, the goodwill that it enjoys in connection with its "SwissPerc" mark, and the reputation of its founder, owner and public face, Nathan Aweida aka Nate Dizzle.

UNFAIR COMPETITION UNDER RCW 19.86

26. Plaintiff realleges and incorporates by reference, as if fully set forth herein, the allegations in paragraphs 1 through 25 above.

27. The actions of Defendant complained of herein constitute unfair methods of competition and unfair or deceptive acts or practices in the conduct of trade or commerce, all in

1 violation of RCW 19.86.020. As a result of Defendant's conduct, Aweida Arts has been
2 damaged in its business or property.

3 **RELIEF REQUESTED**

4 Based upon the above allegations, Plaintiff requests judgment against Defendant as
5 follows:

6 1. That Defendant, its affiliates, officers, agents, servants, employees, attorneys,
7 and all other persons in active concert or participation with any of them, be preliminarily and
8 permanently enjoined and restrained from:

9 a. Using the name "Swiss Perc" or any colorable imitation thereof;

10 b. Using any trademark that imitates or is confusingly similar to or in any
11 way similar to Plaintiff's trademark "SwissPerc," or that is likely to cause confusion, mistake,
12 deception, or public misunderstanding as to the origins of Aweida Arts's and Defendant's
13 respective products and services, or as to Aweida Arts's and Defendant's connectedness; and

14 c. Using <http://pureglass420.com/swiss-perc-50> or any other URL, Internet
15 address, webpage address, or link that includes the word "SwissPerc" or any colorable imitation
16 thereof, including without limitation "swissperc," "swiss-perc," and "swiss-perc-50."

17 2. That Defendant be ordered under 15 U.S.C. §1118 to:

18 a. Discontinue immediately offering, marketing, promoting, distributing,
19 and selling products branded as "Swiss Perc;" and

20 b. Deliver up for destruction, or to destroy and certify that it has destroyed,
21 (i) all remaining inventory and parts branded as "Swiss Perc," (ii) all containers, labels, signs,
22 prints, packages, wrapper, receptacles, advertising, promotional material, or the like bearing a
23 trademark found to infringe on Aweida Arts's trademark, and (iii) all plates, matrices, molds,

1 dies, masters, and other means of making the same; all in possession or custody, or under the
2 control of Defendant.

3 3. That Defendant be required to file with the Court and serve on Aweida Arts
4 within 30 days after entry of the injunction and the order under 15 U.S.C. §1118, a report in
5 writing under oath setting forth in detail the manner and form in which Defendant has complied
6 with the injunction and the order under 15 U.S.C. §1118.

7 4. That Defendant be held liable under 15 U.S.C. §1117:

8 a. For Defendant's profits;

9 b. For all damages sustained by Plaintiff resulting from the acts alleged in
10 this Complaint; and

11 c. For such amount above the amount found as actual damages, not
12 exceeding three times such amount, as the court shall find to be just according to the
13 circumstances of the case.

14 5. That Plaintiff be awarded compensatory damages and Defendant's profits under
15 applicable state law.

16 6. That Plaintiff be awarded under RCW 19.86.090 its actual damages sustained,
17 plus an increased damage award to an amount not more than three times the actual damages
18 sustained but not to exceed \$25,000.

19 7. That Plaintiff be awarded the costs of the suit, including reasonable attorney's
20 fees.

21 8. That Plaintiff be granted such other and further relief as this court deems just and
22 proper.
23

JURY DEMAND

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff demands a trial by jury on all issues properly triable by jury.

DATED: May 20, 2014

SIMBURG, KETTER, SHEPPARD & PURDY, LLP

By: s/ Jonathan I. Feil

Jonathan I. Feil, WSBA No. 14166

George A. Purdy, WSBA #8176

Attorneys for Plaintiff

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Seattle, WA 98104

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Fax: (206) 223-3929

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5 **Exhibit 2**

6 Excerpts from the application file Serial
7 No. 85374436, for the mark SWISS PERC
8 (Stylized/Design), filed by Defendant and
9 at issue in this opposition
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85374436

MARK: SWISS PERC

85374436

CORRESPONDENT ADDRESS:

ERIC S. HYMAN
BLAKELY, SOKOLOFF, TAYLOR &
ZAFMAN LLP
12400 WILSHIRE BLVD FL 7
LOS ANGELES, CA 90025-1019

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Pure Glass Distribution, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

008901.T006

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Search Results

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

Disclaimer

Applicant must disclaim the descriptive wording "Swiss perc" apart from the mark as shown because it merely describes an ingredient, quality, characteristic, function, feature, purpose or use of applicant's goods and/or services. *See* 15 U.S.C. §§1052(e)(1), 1056(a); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987); TMEP §§1213, 1213.03(a).

Specifically, the attached evidence from shows that “Swiss perc” identifies a type of water pipe. The example labeled “perc6” specifically refers to the “Swiss perc design” which features a bowl containing numerous holes in the glass, like Swiss cheese. Apparently, the applicant offers “Swiss perc” water pipes.

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark; it does not affect the appearance of the mark. TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive of the goods, and is wording or an illustration that others would need to use to describe or show their goods and services in the marketplace. 15 U.S.C. §1052(e); *see* TMEP §§1209.03(f), 1213.03 *et seq.*

Applicant may submit the following standardized format for a disclaimer:

No claim is made to the exclusive right to use “Swiss perc” apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

Mark Description

The description of the mark is accurate but incomplete because it does not describe all the significant aspects of the applied-for mark. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. *See* 37 C.F.R. §2.37; TMEP §§808 *et seq.*

Therefore, applicant must provide a more complete description of the applied-for mark. The following is suggested:

The mark consists of the wording SWISS PERC in black in stylized form on a white rectangle. The white rectangle is beneath a red square. Inside the red square are 7 white circles arranged in a larger circle.

The applicant also must amend its color claim to:

The colors red, white, and black are claimed as features of the mark.

Identification of Goods

The wording used to describe the goods is indefinite and must be clarified because “accessories for tobacco water pipes” is vague. *See* TMEP §1402.01. The applicant must list each such item by its common commercial name, as in “tobacco pipe cleaners.”

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

An applicant may amend an identification of goods only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

/Doritt Carroll/
Trademark Examining Attorney
Law Office 116
Phone: (571) 272-9138
doritt.carroll@uspto.gov
www.uspto.gov/teas/index.html

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Attorney Reference No. 008901.T006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:

Pure Glass Distribution, Inc.

Serial No.: 85/374,436

Filing Date: July 18, 2011

Mark: **SWISS PERC plus Design**

Examining Attorney:
Doritt L. Carroll
Law Office 116

RESPONSE TO OFFICE ACTION

Mail Stop Responses – No Fee
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

In response to the outstanding Office Action mailed September 27, 2011, please amend the above-identified application as follows:

Please enter the following disclaimer:

No claim is made to the exclusive right to use "Swiss perc" apart from the mark as shown.

Please amend the description of the applied for mark as follows:

The mark consists of the wording SWISS PERC in black in stylized form on a white rectangle. The white rectangle is beneath a red square. Inside the red square are 7 white circles arranged in a larger circle.

Please also amend the color claim to read as follows:

The colors red, white, and black are claimed as features of the mark.

Regarding the identification of goods, please amend the identification of goods changing "accessories for tobacco water pipes" to --accessories for tobacco water pipes, namely, bowls--.



03-27-2012

Remarks

In response to the above-noted Office Action, Applicant has disclaimed Swiss Perc, amended the description of the mark, the color claim, and the identification of goods as requested by the Examiner.

Inasmuch as there are no other outstanding issues and there are no conflicting marks which would bar registration under Trademark Act Section 2(d), Applicant submits that the subject application is now in condition for allowance. Accordingly, an early publication in the Official Gazette is requested.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Dated:

3/22/2012

By:

Eric S. Hyman

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Responses – NO FEE, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on the date shown below.

Melinda Mechoso

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5 **Exhibit 3**

6 Excerpts from the application file Serial
7 No. 85407750, for the mark SWISSPERC
8 (words only), filed by Opposer
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To: Aweida, Nathan (jfeil@sksp.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85407750 - SWISSPERC - N/A
Sent: 7/6/2012 7:45:38 AM
Sent As: ECOM102@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85407750

MARK: SWISSPERC

85407750

CORRESPONDENT ADDRESS:

JONATHAN I. FEIL
SIMBURG, KETTER, SHEPPARD & PURDY, LLP
999 3RD AVE STE 2525
SEATTLE, WA 98104-4089

GENERAL TRADEMARK INFORMATION
<http://www.uspto.gov/trademarks/index.jsp>

APPLICANT: Aweida, Nathan

CORRESPONDENT'S REFERENCE/DOCKET NO. :

N/A

CORRESPONDENT E-MAIL ADDRESS:

jfeil@sksp.com

SUSPENSION NOTICE: NO RESPONSE NEEDED

ISSUE/MAILING DATE: 7/6/2012

The trademark examining attorney is suspending action on the application for the reason(s) stated below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq.*

The USPTO will periodically conduct a status check of the application to determine whether suspension remains appropriate, and the trademark examining attorney will issue as needed an inquiry letter to applicant regarding the status of the matter on which suspension is based. TMEP §§716.04, 716.05. Applicant will be notified when suspension is no longer appropriate. *See* TMEP §716.04.

No response to this notice is necessary; however, if applicant wants to respond, applicant should use the

“Response to Suspension Inquiry or Letter of Suspension” form online at <http://teasroa.uspto.gov/rsi/rsi>.

The effective filing date of the pending application(s) identified below precedes the filing date of applicant’s application. If the mark in the referenced application(s) registers, applicant’s mark may be refused registration under Section 2(d) because of a likelihood of confusion with that registered mark(s).

See 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, action on this application is suspended until the earlier-filed referenced application(s) is either registered or abandoned. 37 C.F.R. §2.83(c). A copy of information relevant to this referenced application(s) was sent previously.

- Application Serial No(s). **85374436**

/Jordan A. Baker/
U.S. Patent and Trademark Office
Law Office 102
571-272-8844
jordan.baker@uspto.gov

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

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Exhibit 4
Declaration of Jonathan Feil

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6 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
7 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

8 NATHAN AWEIDA,

9 Opposer/Plaintiff,

10 v.

11 PURE GLASS DISTRIBUTION, INC.,

12 Applicant/Defendant.

Opposition No. 91207216

13 **DECLARATION OF JONATHAN FEIL**

14 Jonathan I. Feil declares as follows:

15 I am an attorney in good standing in Washington and attorney for the Opposer. I submit
16 this declaration based upon personal knowledge and upon the documents referred to in this
17 declaration.

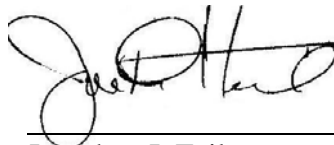
18 On behalf of Opposer, I am submitting a confidential statement under seal, as
19 evidence of “good and sufficient cause” under 37 CFR § 2.132. The reason for requesting
20 confidential treatment for the statement is that it reveals personal and medical information for
21 which there is no need in the public record. Confidential treatment and filing under seal are
22 authorized by the Provisions for Protecting Confidentiality of Information Revealed During
23

1 Board Proceeding, signed by the parties on December 12, 2012 and attached as Exhibit 4 to
2 the foregoing document.

3 It is not feasible to redact this document for the public record by selectively removing
4 only the confidential material, since such material encompasses the entire statement.

5 I declare under penalty of perjury under the laws of the United States that the foregoing
6 is true and correct.

7 DATED: May 22, 2014

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9 _____

10 Jonathan I. Feil
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Exhibit 5

Provisions for Protecting Confidentiality of
Information Revealed During
Board Proceeding,
signed by the parties on December 12, 2012

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5 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
6 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

7 In the matter of trademark application Serial No.: 85374436
8 For the mark: SWISS PERC (Stylized/Design)
9 Published in the Official Gazette on: May 29, 2012

10 NATHAN AWEIDA,

11 Opposer/Plaintiff,

12 v.

13 PURE GLASS DISTRIBUTION, INC.,

14 Applicant/Defendant.

Opposition No. 91207216

15 **PROVISIONS FOR PROTECTING**
16 **CONFIDENTIALITY OF INFORMATION**
17 **REVEALED DURING BOARD PROCEEDING**

18 Information disclosed by any party or non-party witness during this proceeding may
19 be considered confidential, a trade secret, or commercially sensitive by a party or witness. To
20 preserve the confidentiality of the information so disclosed, the parties have agreed to be
21 bound by the following provisions ("order") and by any additional provisions to which they
22 may agree and attach to this order, and to present this agreement for entry by the Board as an
23 order that the parties be bound by the provisions within. As used in this order, the term
"information" covers both oral testimony and documentary material.

PROVISIONS FOR PROTECTING
CONFIDENTIALITY OF INFORMATION
REVEALED DURING BOARD PROCEEDING - 1

1 Agreement of the parties is indicated by the signatures of the parties' attorneys and/or
2 the parties themselves at the conclusion of the order. Imposition of the terms by the Board is
3 indicated by written approval of the agreement by a Board attorney or Administrative
4 Trademark Judge. If the parties have signed the order, they may have created a contract. The
5 terms are binding from the date the parties or their attorneys sign the order, in standard form
6 or as modified or supplemented, or from the date of imposition by a Board attorney or judge,
7 whichever date occurs first.

8 **TERMS OF ORDER**

9 **1) Classes of Protected Information.**

10 The Rules of Practice in Trademark Cases provide that all *inter partes* proceeding
11 files, as well as the involved registration and application files, are open to public inspection.
12 The terms of this order are not to be used to undermine public access to files. When
13 appropriate, however, a party or witness, on its own or through its attorney, may seek to
14 protect the confidentiality of information by employing one of the following designations.

15 **Confidential** - Material to be shielded by the Board from public access.

16 **Highly Confidential** - Material to be shielded by the Board from public access and
17 subject to agreed restrictions on access even as to the parties and/or their attorneys.

18 **Trade Secret/Commercially Sensitive** - Material to be shielded by the Board from
19 public access, restricted from any access by the parties, and available for review by outside
20 counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent
21 experts or consultants for the parties.

1 **2) Information Not to Be Designated as Protected.**

2 Information may not be designated as subject to any form of protection if it (a) is, or
3 becomes, public knowledge, as shown by publicly available writings, other than through
4 violation of the terms of this document; (b) is acquired by a non-designating party or non-
5 party witness from a third party lawfully possessing such information and having no
6 obligation to the owner of the information; (c) was lawfully possessed by a non-designating
7 party or non-party witness prior to the opening of discovery in this proceeding, and for which
8 there is written evidence of the lawful possession; (d) is disclosed by a non-designating party
9 or non-party witness legally compelled to disclose the information; or (e) is disclosed by a
10 non-designating party with the approval of the designating party.

11 **3) Access to Protected Information.**

12 The provisions of this order regarding access to protected information are subject to
13 modification by written agreement of the parties or their attorneys, or by motion filed with
14 and approved by the Board.

15 Judges, attorneys, and other employees of the Board are bound to honor the parties'
16 designations of information as protected but are not required to sign forms acknowledging the
17 terms and existence of this order. Court reporters, stenographers, video technicians or others
18 who may be employed by the parties or their attorneys to perform services incidental to this
19 proceeding will be bound only to the extent that the parties or their attorneys make it a
20 condition of employment or obtain agreements from such individuals, in accordance with the
21 provisions of paragraph 4.

22 **a) Parties** are defined as including individuals, officers of corporations,
23 partners of partnerships, and management employees of any type of business organization.

1 **b) Attorneys** for parties are defined as including **in-house counsel** and
2 **outside counsel**, including support staff operating under counsel's direction, such as
3 paralegals or legal assistants, secretaries, and any other employees or independent contractors
4 operating under counsel's instruction.

5 **c) Independent experts or consultants** include individuals retained by a
6 party for purposes related to prosecution or defense of the proceeding but who are not
7 otherwise employees of either the party or its attorneys.

8 **d) Non-party witnesses** include any individuals to be deposed during
9 discovery or trial, whether willingly or under subpoena issued by a court of competent
10 jurisdiction over the witness.

11 **Parties** and their **attorneys** shall have access to information designated as
12 **confidential or highly confidential**, subject to any agreed exceptions.

13 **Outside counsel, but not in-house counsel**, shall have access to information
14 designated as **trade secret/commercially sensitive**.

15 **Independent experts or consultants, non-party witnesses, and any other individual**
16 not otherwise specifically covered by the terms of this order may be afforded access to
17 **confidential or highly confidential** information in accordance with the terms that follow in
18 paragraph 4. Further, **independent experts or consultants** may have access to **trade**
19 **secret/commercially sensitive** information if such access is agreed to by the parties or
20 ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

21 **4) Disclosure to Any Individual.**

22 Prior to disclosure of protected information by any party or its attorney to any
23 individual not already provided access to such information by the terms of this order, the

1 individual shall be informed of the existence of this order and provided with a copy to read.
2 The individual will then be required to certify in writing that the order has been read and
3 understood and that the terms shall be binding on the individual. No individual shall receive
4 any protected information until the party or attorney proposing to disclose the information has
5 received the signed certification from the individual. A form for such certification is attached
6 to this order. The party or attorney receiving the completed form shall retain the original.

7 **5) Disclosure to Independent Experts or Consultants.**

8 In addition to meeting the requirements of paragraph 4, any party or attorney
9 proposing to share disclosed information with an independent expert or consultant must also
10 notify the party which designated the information as protected. Notification must be
11 personally served or forwarded by certified mail, return receipt requested, and shall provide
12 notice of the name, address, occupation and professional background of the expert or
13 independent consultant.

14 The party or its attorney receiving the notice shall have ten (10) business days to
15 object to disclosure to the expert or independent consultant. If objection is made, then the
16 parties must negotiate the issue before raising the issue before the Board. If the parties are
17 unable to settle their dispute, then it shall be the obligation of the party or attorney proposing
18 disclosure to bring the matter before the Board with an explanation of the need for disclosure
19 and a report on the efforts the parties have made to settle their dispute. The party objecting to
20 disclosure will be expected to respond with its arguments against disclosure or its objections
21 will be deemed waived.
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1 **6) Responses to Written Discovery.**

2 Responses to interrogatories under Federal Rule 33 and requests for admissions under
3 Federal Rule 36, and which the responding party reasonably believes to contain protected
4 information shall be prominently stamped or marked with the appropriate designation from
5 paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as
6 soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of
7 the error. The parties should inform the Board only if necessary because of the filing of
8 protected information not in accordance with the provisions of paragraph 12.

9 **7) Production of Documents.**

10 If a party responds to requests for production under Federal Rule 34 by making copies
11 and forwarding the copies to the inquiring party, then the copies shall be prominently stamped
12 or marked, as necessary, with the appropriate designation from paragraph 1. If the responding
13 party makes documents available for inspection and copying by the inquiring party, all
14 documents shall be considered protected during the course of inspection. After the inquiring
15 party informs the responding party what documents are to be copied, the responding party will
16 be responsible for prominently stamping or marking the copies with the appropriate
17 designation from paragraph 1. Any inadvertent disclosure without appropriate designation
18 shall be remedied as soon as the disclosing party learns of its error, by informing all adverse
19 parties, in writing, of the error. The parties should inform the Board only if necessary because
20 of the filing of protected information not in accordance with the provisions of paragraph 12.

21 **8) Depositions.**

22 Protected documents produced during a discovery deposition, or offered into evidence
23 during a testimony deposition shall be orally noted as such by the producing or offering party

1 at the outset of any discussion of the document or information contained in the document. In
2 addition, the documents must be prominently stamped or marked with the appropriate
3 designation.

4 During discussion of any non-documentary protected information, the interested party
5 shall make oral note of the protected nature of the information.

6 The transcript of any deposition and all exhibits or attachments shall be considered
7 protected for 30 days following the date of service of the transcript by the party that took the
8 deposition. During that 30-day period, either party may designate the portions of the
9 transcript, and any specific exhibits or attachments, that are to be treated as protected, by
10 electing the appropriate designation from paragraph 1. Appropriate stampings or markings
11 should be made during this time. If no such designations are made, then the entire transcript
12 and exhibits will be considered unprotected.

13 **9) Filing Notices of Reliance.**

14 When a party or its attorney files a notice of reliance during the party's testimony
15 period, the party or attorney is bound to honor designations made by the adverse party or
16 attorney, or non-party witness, who disclosed the information, so as to maintain the protected
17 status of the information.

18 **10) Briefs.**

19 When filing briefs, memoranda, or declarations in support of a motion, or briefs at
20 final hearing, the portions of these filings that discuss protected information, whether
21 information of the filing party, or any adverse party, or any non-party witness, should be
22 redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.
23

1 **11) Handling of Protected Information.**

2 Disclosure of information protected under the terms of this order is intended only to
3 facilitate the prosecution or defense of this case. The recipient of any protected information
4 disclosed in accordance with the terms of this order is obligated to maintain the confidentiality
5 of the information and shall exercise reasonable care in handling, storing, using or
6 disseminating the information.

7 **12) Redaction; Filing Material With the Board.**

8 When a party or attorney must file protected information with the Board, or a brief that
9 discusses such information, the protected information or portion of the brief discussing the
10 same should be redacted from the remainder. A rule of reasonableness should dictate how
11 redaction is effected.

12 Redaction can entail merely covering a portion of a page of material when it is copied
13 in anticipation of filing but can also entail the more extreme measure of simply filing the
14 entire page under seal as one that contains primarily confidential material. If only a sentence
15 or short paragraph of a page of material is confidential, covering that material when the page
16 is copied would be appropriate. In contrast, if most of the material on the page is confidential,
17 then filing the entire page under seal would be more reasonable, even if some small quantity
18 of non-confidential material is then withheld from the public record. Likewise, when a multi-
19 page document is in issue, reasonableness would dictate that redaction of the portions or pages
20 containing confidential material be effected when only some small number of pages contain
21 such material. In contrast, if almost every page of the document contains some confidential
22 material, it may be more reasonable to simply submit the entire document under seal.

1 **Occasions when a whole document or brief must be submitted under seal should be very**
2 **rare.**

3 Protected information, and pleadings, briefs or memoranda that reproduce, discuss or
4 paraphrase such information, shall be filed with the Board under seal. The envelopes or
5 containers shall be prominently stamped or marked with a legend in substantially the
6 following form:

7 **CONFIDENTIAL**

8 *This envelope contains documents or information that are subject to a protective*
9 *order or agreement. The confidentiality of the material is to be maintained and*
10 *the envelope is not to be opened, or the contents revealed to any individual,*
11 *except by order of the Board.*

12 **13) Acceptance of Information; Inadvertent Disclosure.**

13 Acceptance by a party or its attorney of information disclosed under designation as
14 protected shall not constitute an admission that the information is, in fact, entitled to
15 protection. Inadvertent disclosure of information which the disclosing party intended to
16 designate as protected shall not constitute waiver of any right to claim the information as
17 protected upon discovery of the error.

18 **14) Challenges to Designations of Information as Protected.**

19 If the parties or their attorneys disagree as to whether certain information should be
20 protected, they are obligated to negotiate in good faith regarding the designation by the
21 disclosing party. If the parties are unable to resolve their differences, the party challenging the
22 designation may make a motion before the Board seeking a determination of the status of the
23 information.

1 A challenge to the designation of information as protected must be made substantially
2 contemporaneous with the designation, or as soon as practicable after the basis for challenge
3 is known. When a challenge is made long after a designation of information as protected, the
4 challenging party will be expected to show why it could not have made the challenge at an
5 earlier time.

6 The party designating information as protected will, when its designation is timely
7 challenged, bear the ultimate burden of proving that the information should be protected.

8 **15) Board's Jurisdiction; Handling of Materials After Termination.**

9 The Board's jurisdiction over the parties and their attorneys ends when this proceeding
10 is terminated. A proceeding is terminated only after a final order is entered and either all
11 appellate proceedings have been resolved or the time for filing an appeal has passed without
12 filing of any appeal.

13 The parties may agree that archival copies of evidence and briefs may be retained,
14 subject to compliance with agreed safeguards. Otherwise, within 30 days after the final
15 termination of this proceeding, the parties and their attorneys shall return to each disclosing
16 party the protected information disclosed during the proceeding, and shall include any briefs,
17 memoranda, summaries, and the like, which discuss or in any way refer to such information.
18 In the alternative, the disclosing party or its attorney may make a written request that such
19 materials be destroyed rather than returned.

20 **16) Other Rights of the Parties and Attorneys.**

21 This order shall not preclude the parties or their attorneys from making any applicable
22 claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any
23

1 motion with the Board for relief from a particular provision of this order or for additional
2 protections not provided by this order.

3 By Agreement of the Following, effective: 12/12/2012

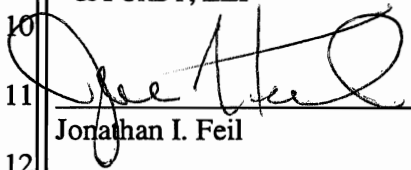
[insert signature date]

4
5 For Plaintiff:

6 JONATHAN I. FEIL

7 [print or type name and title of
8 individual signing for plaintiff]

9 SIMBURG, KETTER, SHEPPARD
& PURDY, LLP

10 
11 Jonathan I. Feil

12 999 Third Avenue, Suite 2525
13 Seattle, WA 98104-4089
14 Email: jfeil@sksp.com, afoster@sksp.com

15 Attorneys for Plaintiff/Opposer

For Defendant:

PETER BROMAGHIM

[print or type name and title of
individual signing for defendant]

BLAKELY SOKOLOFF TAYLOR
& ZAFMAN LLP

10 
11 Eric S. Hyman
12 Pete Bromaghim

12400 Wilshire Blvd, Fl 7
Los Angeles, CA 90025-1019
Email: pete_bromaghim@bstz.com,
kyle_samia@bstz.com,
eric_hyman@bstz.com,
alexis_karriker@bstz.com,
tm_filings@bstz.com

Attorneys for Defendant/Applicant

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Exhibit 6
[Proposed] Amended Notice of Opposition

ESTTA Tracking number: **ESTTA496808**

Filing date: **09/26/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition **AMENDED**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Nathan Aweida
Granted to Date of previous extension	09/26/2012
Address	1300 S Dearborn St Seattle, WA 98144-2702 UNITED STATES
Party who filed Extension of time to oppose	NathanAweida
Relationship to party who filed Extension of time to oppose	Name was entered in ESTTA database without a space between first and last name.

Attorney information	Jonathan I. Feil Simburg, Ketter, Sheppard & Purdy, LLP 999 Third Avenue, Suite 2525 Seattle, WA 98104-4089 UNITED STATES jfeil@sksp.com Phone:(206) 382-2600
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Applicant Information

Application No	85374436	Publication date	05/29/2012
Opposition Filing Date	09/26/2012	Opposition Period Ends	09/26/2012
Applicant	Pure Glass Distribution, Inc. 5649 East Washington Boulevard City of Commerce, CA 90040 UNITED STATES		


Goods/Services Affected by Opposition


Class 034. All goods and services in the class are opposed, namely: accessories for tobacco water pipes, namely, bowls

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85407750	Application Date	08/25/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SWISSPERC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 2010/08/31 First Use In Commerce: 2010/08/31 Works of art made of glass		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	Works of art made of glass, artisan-produced glassware designs		

	which are also functional water pipes
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Attachments	85407750#TMSN.jpeg (1 page)(bytes) SwissPerc photo1-opp.jpg 092612Notice_of_Opposition-SwissPerc.pdf (17 pages)(261004 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jonathan I. Feil/
Name	Jonathan I. Feil
Date	09/26/2012 Amended 05/22/2014

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6 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
7 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

8 In the matter of trademark application Serial No.: 85374436
9 For the mark: SWISS PERC (Stylized/Design)
10 Published in the Official Gazette on: May 29, 2012

11 NATHAN AWEIDA,

Opposition No. 91207216

12 Opposer/Plaintiff,

13 v.

14 PURE GLASS DISTRIBUTION, INC.,

15 Applicant/Defendant.

16
17 **PROPOSED AMENDED**
NOTICE OF OPPOSITION

18 Nathan Aweida (“Opposer”) believes that he will be damaged by registration of the
19 mark shown in above-identified application and hereby opposes the registration of the mark.

20 The grounds for opposition are as follows:

21 1. Opposer, Nathan Aweida, is a citizen of the United States residing in the State
22 of Washington. Mr. Aweida also uses the artist pseudonym Nate Dizzle. Mr. Aweida is the
23

owner of Aweida Arts, Inc., a corporation organized under the laws of the State of Washington with offices in Seattle, Washington.

2. Opposer is the owner of the trademark SwissPerc (“Opposer’s Mark”), which has been used continuously by Opposer or a related company for works of art made of glass, including artisan-produced glassware designs which are also functional water pipes, since a date prior to the earliest date that could be asserted as a priority date for the trademark of the Applicant.

3. Opposer applied for federal registration of Opposer’s Mark on August 25, 2011, under Application Serial Number 85407750 for the trademark SwissPerc for “works of art made of glass” in Class 21.

4. Applicant, Pure Glass Distribution, Inc., has applied under Application Serial Number 85374436 (the “Application”) for federal trademark registration of the mark SWISS PERC (Stylized/Design) (the “Applied-for Mark”), based on its allegation of a bona fide intention to use the Applied-for Mark in commerce for “accessories for tobacco water pipes, namely, bowls” in International Class 34.

5. Opposer attaches hereto as Exhibit 1 a copy of the Application and requests that it be received in evidence to prove the matters claimed by Applicant as the basis for registration of the Applied-for Mark.

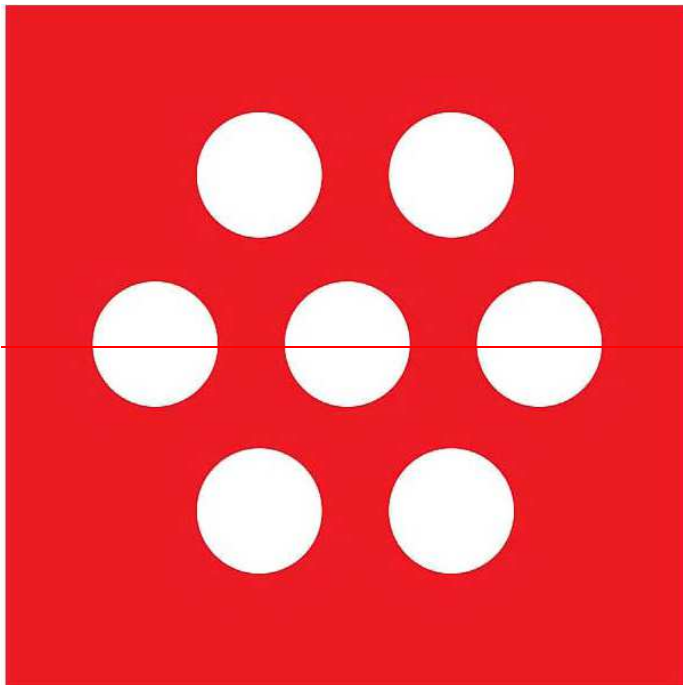
6. The Applied-for Mark is confusingly similar to Opposer’s Mark, and the goods identified in the Application are similar or identical to, marketed and sold in similar or the same channels of trade as, marketed and sold to similar or the same purchasers, and marketed and sold for a similar or the same use as the goods for which Opposer’s Mark has

1 been used. Accordingly, the use or registration of the Applied-for Mark is likely to cause
2 confusion or mistake or to deceive.

3 7. The Applied-for Mark has been cited against Opposer's Mark by the
4 trademark examining attorney as grounds for suspending action on Opposer's Application Serial
5 Number 85407750.

6 8. By virtue of Opposer's original creation, adoption, and prior and continuous
7 use of Opposer's Mark, Opposer has exclusive right to use in commerce and register
8 Opposer's Mark in connection with works of art made of glass, water pipes, and accessories
9 for water pipes. The registration of the Applied-for Mark would be in derogation of those
10 rights and would be in violation of Section 2 of the Lanham Act, 15 U.S.C. §1052.

11 ~~9. The Applied for Mark incorporates the following graphic design (the~~
12 ~~"Design"), which the Application describes as "a red square" inside of which "are 7 white~~
13 ~~circles arranged in a larger circle" (see Exhibit 1):~~



10. — The Design is confusingly similar to a design which Opposer originally created and adopted in 2007 and which has been used by Opposer or a related company at least as early as April 2008 on goods which are similar or identical to, marketed and sold in similar or the same channels of trade as, marketed and sold to similar or the same purchasers, and marketed and sold for a similar or the same use as the goods identified in the Application. Accordingly, the use or registration of the Design as part of the Applied for Mark is likely to cause confusion or mistake or to deceive.

11. — Since at least as early as April 2008, Opposer or a related company has marketed and sold products with visual appearance characteristics that are distinctive and are perceived by customers as identifying the source of the product. Although Applicant bases the Application on an alleged intention to use the Applied for Mark in commerce, Applicant has since approximately September 1, 2011, used the mark to reproduce, distribute, market and sell products whose design (as shown below in Figure 1) is (a) likely to cause confusion, or to cause mistake, or to deceive as to the origin, sponsorship, or approval of Applicant's goods or commercial activities and (b) infringes Opposer's copyright in its products as works of visual art. The Design claimed by Applicant as part of the Applied for Mark is an integral and inseparable element in Applicant's confusing, deceptive and infringing product design.

Figure 1.



Source: http://pureglass420.com/wp-content/uploads/2012/02/SWISS_PERC/SWISS_PERC_FROST_19_1K.jpg (browsed September 26, 2012)



Source: Photograph taken by Opposer in 2007

1 ~~12.9.~~ Use of the Applied-for Mark by Applicant pursuant to its intent-to-use
2 application would be in non-compliance with other federal law, and accordingly the
3 commerce recited in the Application would not be lawful.

4 ~~13.10.~~ Applicant filed the Application in the Trademark Office, through its lawyers,
5 declaring: (a) that willful false statements may jeopardize the validity of the Application and
6 any resulting registration, (b) that all statements in the Application made of the declarant's
7 own knowledge were true and all statements made on information and belief were believed to
8 be true, (c) that the declarant believed Applicant to be entitled to use the Applied-for Mark in
9 commerce, and (d) that to the declarant's knowledge and belief no other person, firm,
10 corporation, or association has the right to use the mark in commerce, either in the identical
11 form thereof or in such near resemblance thereto as to be likely, when used on or in
12 connection with the goods or services of such other person, to cause confusion, or to cause
13 mistake, or to deceive.

14 ~~14.11.~~ On information and belief, Applicant filed the Application, through its
15 lawyers, for a mark that Applicant is not entitled to use in commerce and that Opposer has
16 the right to use in commerce, either in the identical form thereof or in such near resemblance
17 thereto as to be likely, when used on or in connection with Opposer's goods or services, to
18 cause confusion, or to cause mistake, or to deceive, as was, and still is, known by Applicant.

19 ~~15.12.~~ On information and belief, Applicant committed fraud on the Trademark
20 Office by claiming that Applicant is entitled to use in commerce the mark sought to be
21 registered and by intentionally concealing from the Trademark Office that Applicant is not
22 entitled to use such mark in commerce and that Opposer has the right to use the mark in
23 commerce, either in the identical form thereof or in such near resemblance thereto as to be

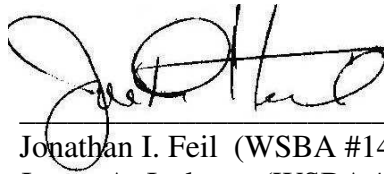
1 likely, when used on or in connection with Opposer's goods or services of such other person,
2 to cause confusion, or to cause mistake, or to deceive, as was, and still is, known by
3 Applicant.

4 WHEREFORE, Opposer requests that this opposition be sustained in favor of
5 Opposer and that registration be refused for Application Serial Number 85374436.

6 Respectfully submitted,

7 SIMBURG, KETTER, SHEPPARD & PURDY, LLP

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9 By:



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DATED: ~~September 26, 2012~~
Amended May 22, 2014